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REMARKSRestriction

Applicants acknowledge with gratitude the Examiner's conclusion in numbered paragraph 4 of the Office Action that "a restriction is improper at this time."

Objection to the Specification – 37 C.F.R. § 1.75(d)(1)

The Office Action objects to the specification for failing to provide a proper antecedent basis for the claimed subject matter under 37 C.F.R. § 1.75(d)(1), MPEP § 608.01(o), and MPEP § 2181IV. The Office Action states at paragraph 8 of the Office Action:

The claims are replete with these errors. Some examples follow:

- a. The "means for providing" as recited in claims 11 and 21
- b. The "means for detecting" as recited in claims 12 and 22
- c. The "means for reading" as recited in claims 14 and 24

The bare assertion that the "claims are replete with these errors" gives the applicants inadequate notification of the reasons for the objection. 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for an objection, including "such information and references as may be useful in judging of the propriety of continuing the prosecution...." 37 C.F.R. § 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of "...the particular figures(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)...." In this Office Action, the assertion that the "claims are replete with these errors" is accompanied by no explanation whatsoever of what 'these errors' are. Without knowing any reason for the objection, the Applicants cannot understand the

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basis for the objection. The objection therefore fails to meet the requirements of 35 U.S.C. § 132 and should be withdrawn.

Because the Office Action does not comport with 35 U.S.C. § 132 to give enough information for the Applicants to fashion a response to the Office Action, Applicants are under no obligation to respond further. Nevertheless, in an effort to move the case forward, Applicants will attempt to provide meaningful comment regarding the three means claims mentioned in paragraph 8 of the Office Action. Applicants' legal obligation regarding enablement of means claims is set forth in MPEP § 2181 which states, "37 CFR 1.75(d)(1) provides, in part, that 'the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.'"¹ In determining whether a means-plus-function has support in the written description, "[t]he proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)."²

The means claims specifically mentioned in paragraph 8 of the Office Action, claims 11, 12, 14, 21, 22, and 24, are in fact well enabled in the specification:

- The limitation "means for providing" from claims 11 and 12 is enabled, for example, at least at the following locations: in the specification beginning at line 4 of page 2 and beginning at line 34 of page 10, referencing Figure 2.
- The limitation "means for detecting" from claims 12 and 22 is enabled, for example, at least at the following locations: in the specification beginning at line

¹ *Manual of Patenting Examination Procedure* § 2181 IV.

² *Manual of Patenting Examination Procedure* § 2181 II.

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15 of page 2, beginning at line 12 of page 11, referencing Figure 2, and beginning at line 34 of page 11, referencing Figure 4.

- The limitation “means for reading” from claims 14 and 24 is enabled, for example, at least at the following locations: in the specification beginning at line 11 of page 2, beginning at line 5 of page 11, referencing Figure 2, and beginning at line 37 of page 11, referencing Figure 4.

In view of the detailed descriptions in the specification, it is clear that the specification provides clear support or antecedent basis within the meaning of 37 CFR 1.75. The Applicants therefore traverse the objection to the specification, and respectfully request the withdrawal of the objection.

Claim Rejections – 35 U.S.C. § 112, 2nd Paragraph

Claims 1-30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Office Action states at paragraph 10 of the Office Action:

The claims are replete with errors. Some examples follow.

- i. In claim 1, it is unclear if the “detecting changes” detects changes to the attribute definitions (as claimed) or changes in the ‘values’ of the attributes.
- ii. In claim 11 and 21, it is unclear what is the corresponding structure in the ‘means for detecting changes....’ In particular, it is unclear which hardware and/or software elements make up the “means for detecting changes....”

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iii. Also in claim 12, the term "OSGI" is indefinite.³

The bare assertion that the "claims are replete with errors" gives the applicants inadequate notification of the reasons for the rejection. As mentioned above, 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for a rejection, including "such information and references as may be useful in judging of the propriety of continuing the prosecution...." 37 C.F.R. § 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of "...the particular figures(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)...." MPEP § 707.07(d) warns against omnibus rejections as, "...stereotyped and usually not informative and should therefore be avoided." MPEP § 2173 states relating to rejections under 35 U.S.C. § 112, second paragraph, "If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action."⁴ In this Office Action, the assertion that the "claims are replete with errors" is accompanied by no explanation whatsoever of what 'these errors' are. Without knowing any reason for the rejection, the Applicants cannot understand the basis for the rejection. The rejection therefore fails to meet the requirements of 35 U.S.C. § 132 and should be withdrawn.

Because the Office Action does not comport with 35 U.S.C. § 132 to give enough information for the Applicants to fashion a response to the Office Action, Applicants are under no obligation to respond further. Nevertheless, in an effort to move the case forward, Applicants will attempt to provide meaningful comment regarding the three examples mentioned in paragraph 10 of the Office Action. MPEP § 2173 sets forth the standard for compliance with 35 U.S.C. § 112 stating that "...the examiner must consider

³ Office Action at numbered ¶10.

⁴ *Manual of Patenting Examination Procedure* § 2173.02.

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the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.”⁵ MPEP § 2173 further explains, “Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teaching of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.”⁶

The examples specifically mentioned in paragraph 10 of the Office Action, claims 1, 11, 12, and 21, do in fact properly satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, when analyzed in light of the factors from MPEP § 2173 above, including the Applicants’ disclosure:

- The limitation “detecting changes” from claim 1 is definite in light of Applicants’ disclosure, for example, at least at the following locations: in the specification beginning at line 23 of page 2, beginning at line 4 of page 17, referencing Figure 4, and beginning at line 19 of page 17, referencing Figure 5.
- The limitation “means for detecting changing” from claims 11 and 21 is definite in light of Applicants’ disclosure, for example, at least at the following locations: in the specification beginning at line 7 of page 16, referencing Figures 1 and 2, beginning at line 24 of page 11, beginning at line 14 of page 11, referencing Figure 1, beginning at line 11 of page 7, and beginning at line 4 of page 17.

⁵ *Manual of Patenting Examination Procedure* § 2173.02; See *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor’s contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph.).

⁶ *Manual of Patenting Examination Procedure* § 2173.02.

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- The limitation "OSGT" from claim 12 is definite in light of Applicants' disclosure, for example, at least at the following locations: in the specification beginning at line 9 of page 12.

In view of the detailed descriptions in the specification, it is clear that the claim language is sufficiently definite to apprise one of ordinary skill in the art of its scope as required by 35 U.S.C. § 112, second paragraph. The Applicants therefore traverse the rejections individually to claims 1-30 under 35 U.S.C. § 112, second paragraph, and respectfully request the withdrawal of the rejections.

Claim Rejections – 35 U.S.C. § 102 Over Reber

Claims 11-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Reber, *et al.* (U.S. Patent No. 5,798,694). Applicants respectfully submit in response that the Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution. In addition, the Office Action has not established anticipation by Reber because the Office Action does not even mention many of the elements of the Applicants' claims. Moreover, examining Reber confirms that Reber does not anticipate each and every element of the Applicants' claims. Finally, the theory of inherency is not available as a basis for rejection of claims in the present case. For all these reasons, the rejections should be withdrawn and the claims should be allowed.

The Office Action Fails To Provide The Applicants With
Information Sufficient To Judge The Propriety Of
Continuing Prosecution As Required By 35 U.S.C. § 132

The Office Action at numbered paragraph 13 sets forth the following omnibus rejection of most of the elements of claim 11 over Reber:

Claims 11-20, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Reber *et al.* (U.S. 5,798,694)("Reber"). Reber

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discloses an RFID inventory system with RFID identification tag code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range...

The mere assertion that Reber anticipates claims 11-20 gives the applicants inadequate notification of the reasons for the rejection. 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for the rejections, including "such information and references as may be useful in judging of the propriety of continuing the prosecution...." 37 C.F.R. § 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of "...the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)...." MPEP § 707.07(d) warns against such omnibus rejections as made in the Office Action as, "...stereotyped and usually not informative and should therefore be avoided." In this Office Action, the assertion that Reber anticipates claims 11-20 of the present application is accompanied by no explanation whatsoever of where in Reber the information relied on by the Examiner may be found. Reber describes, among other things:

- food storage apparatus
- a container for containing a food item
- a first electrical component associated with the container
- a second electrical component associated with the cover
- the first electrical component communicating with the second electrical component

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- communication between electrical components when the cover seals the opening of the container
- the cover that includes a first at least one electrical contact and the container includes a second at least one electrical contact to provide an electrical coupling between the first electrical component and the second electrical component when the cover seals the opening of the container
- one of the first electrical component and the second electrical component includes a sensor, and another of the first electrical component and the second electrical component includes an indicator
- one of the first electrical component and the second electrical component includes at least one of a receiver, a transmitter, a processor, and a memory, and another of the first electrical component and the second electrical component includes an indicator
- one of the first electrical component and the second electrical component includes at least one of a receiver, a transmitter, a processor, and a memory.
- container sized for carrying by an individual
- container has a capacity less than or equal to 10 liters
- determining a first time at which the food item is removed from the storage place
- determining a second time at which the food item is returned to the storage place
- determining time duration that the food item is outside of a storage place

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Reber is a complex reference containing information regarding many technical subjects and other inventions. In this circumstance, it is important for the Office Action to provide some indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Reber the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections. For these reasons alone, the rejection of the claims 11-20 should be withdrawn, and the claims should be allowed.

Office Action Has Not Established Anticipation By Reber
Because The Office Action Does Not Even Mention Many
Of The Elements Of The Applicants' Claims

In the absence of any indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 USC 102. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants point out with respect that the Office Action has not established anticipation by Reber because the Office Action does not even mention many of the elements of the Applicants' claims.

As stated in *Verdegaal Bros. v. Union Oil Co. of California*, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.⁷ The rejected claims 11-20 contain the following elements and limitations:

- means for providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an

⁷ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:

- an RFID identification tag code field,
 - a control value,
 - an acceptable control value range, and
 - an out of range action
- means for detecting changes in the inventory item attributes, wherein means for detecting changes in inventory item attributes include means for reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item
- means for recording detected changes in inventory item attributes
- means for comparing the control value and the acceptable control value range
- means for taking action in dependence upon the result of the comparing and the out of range action
- wherein the means for detecting changes, means for recording detected changes, means for comparing the control value and the acceptable control value range, and means for taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway
- wherein the inventory item attributes further comprise a control value unit field set to 'pounds'

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- wherein means for detecting changes includes means for reading the weight of the inventory item from a scale
- wherein means for recording detected changes comprises means for storing the weight of the inventory item in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'freshness'
- wherein means for detecting changes in the inventory attributes of the inventory item further comprises:
 - means for reading from a clock the time when the inventory item is removed from a refrigerator,
 - means for reading the temperature from a kitchen thermometer,
 - means for reading from the clock the time when the inventory item is returned to the refrigerator, and
 - means for calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature
- wherein means for recording detected changes comprises means for storing the freshness coefficient in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'utilization'

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- wherein means for detecting changes in the inventory attributes of the inventory item includes means for detecting that the inventory item has been removed from and returned to an inventory storage location
- wherein means for recording detected changes comprises means for incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized
- wherein the inventory item comprises a quantity of separate items
- wherein the inventory item attributes further comprise a control value unit field set to 'count'
- wherein means for detecting changes in the inventory attributes includes means for detecting that one of the separate items has been removed from inventory
- wherein means for recording detected changes comprises means for decrementing the control value, wherein the control value represents the quantity of separate items
- wherein the inventory item attributes further comprise:
 - a control value unit field set to 'days', and
 - an inventory date representing the date when the inventory item entered inventory
- wherein means for detecting changes comprises:
 - means for reading from a clock the current date, and

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- means for calculating the age of the inventory item in dependence upon the current date and the inventory date
- wherein means for recording detected changes comprises means for storing the age of the inventory item in the control value
- wherein means for taking action comprises means for emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range
- wherein means for taking action comprises means for emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range
- wherein means for taking action comprises means for sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the control value is outside the acceptable control value range

As mentioned above, the Office Action at numbered paragraph 13, regarding Reber, states:

Claims 11-20, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Reber et. al. (U.S. 5,798,694) ("Reber"). Reber discloses an RFID inventory system with RFID identification tag code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range...

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That is, the Office Action only mentions the following claim limitations and from claim 11 only:

- an RFID inventory system with RFID identification tag code field
- the RFID tag detects changes
- records changes
- compares control values with acceptable values
- takes action if those actions are outside a range

The examiner therefore made no mention whatsoever of the following limitations and elements as required by the Federal Circuit in *Verdegaal Bros.*:

- means for providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:
 - ...
 - a control value,
 - an acceptable control value range, and
 - an out of range action
- means for ... in the inventory item attributes, wherein means for detecting changes in inventory item attributes include means for reading, through an RFID reader, the RFID identification code from the ... associated with the inventory item

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- means for ... detected ... in inventory item attributes
- means for ... and ... control ... range
- means for ...
- wherein the means for detecting changes, means for recording detected changes, means for comparing the control value and the acceptable control value range, and means for taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway
- wherein the inventory item attributes further comprise a control value unit field set to 'pounds'
- wherein means for detecting changes includes means for reading the weight of the inventory item from a scale
- wherein means for recording detected changes comprises means for storing the weight of the inventory item in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'freshness'
- wherein means for detecting changes in the inventory attributes of the inventory item further comprises:
 - means for reading from a clock the time when the inventory item is removed from a refrigerator,

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- means for reading the temperature from a kitchen thermometer,
- means for reading from the clock the time when the inventory item is returned to the refrigerator, and
- means for calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature
- wherein means for recording detected changes comprises means for storing the freshness coefficient in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'utilization'
- wherein means for detecting changes in the inventory attributes of the inventory item includes means for detecting that the inventory item has been removed from and returned to an inventory storage location
- wherein means for recording detected changes comprises means for incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized
- wherein the inventory item comprises a quantity of separate items
- wherein the inventory item attributes further comprise a control value unit field set to 'count'
- wherein means for detecting changes in the inventory attributes includes means for detecting that one of the separate items has been removed from inventory

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- wherein means for recording detected changes comprises means for decrementing the control value, wherein the control value represents the quantity of separate items
- wherein the inventory item attributes further comprise:
 - a control value unit field set to 'days', and
 - an inventory date representing the date when the inventory item entered inventory
- wherein means for detecting changes comprises:
 - means for reading from a clock the current date, and
 - means for calculating the age of the inventory item in dependence upon the current date and the inventory date
- wherein means for recording detected changes comprises means for storing the age of the inventory item in the control value
- wherein means for taking action comprises means for emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range
- wherein means for taking action comprises means for emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range

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- wherein means for taking action comprises means for sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the control value is outside the acceptable control value range

Though the Office Action rejects claims 11-20 as anticipated by Reber, the Office Action only cites a few phrases from claim 11 of the present application to support the rejection under 35 U.S.C. § 102(b). The Office Action does not mention any of the additional elements claimed in dependent claims 12-20 as being anticipated by Reber. Because the Office Action does not mention all of the elements and limitations of claims 11-20, the rejections under 35 U.S.C. § 102(b) should be withdrawn, and claims 11-20 should be allowed.

Examination Of Reber Confirms That Reber Does Not Anticipate
Each And Every Element As Set Forth In The Applicants' Claims

In the absence of any indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §102. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

To anticipate claims 11-20 under 35 U.S.C. § 102(b), two basic requirements must be met. As stated in *Verdegaal Bros. v. Union Oil Co. of California*, the first requirement of anticipation is that Reber must disclose each and every element as set forth in Applicants' claims.⁸ The second requirement of anticipation from *In re Hoeksema* is that Reber must

⁸ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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enable Applicants' claims.⁹ Reber does not meet either requirement and therefore does not anticipate Applicants' claims.

As mentioned above, the Office Action at numbered paragraph 13, regarding Reber, states:

Claims 11-20, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Reber et. al. (U.S. 5,798,694)("Reber"). Reber discloses an RFID inventory system with RFID identification tag code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range...

What Reber in fact discloses is a "FOOD STORAGE APPARATUS AND METHODS AND SYSTEMS FOR MONITORING A FOOD ITEM."¹⁰ The principal object of Reber is described in column 10, lines 58-60, stating:

Because the various embodiments of the present invention provide communication of signals between a cover and a container, they provide a significant improvement in that various functions provided by a food storage apparatus can be distributed therein. Additionally, the various embodiments of the present invention as herein-described monitor a condition of a food item to alert an individual of a discard condition of a food item requiring refrigeration.

In fact, the overall message of Reber is that of a food storage apparatus capable of indicating when food should be discarded. For further examples of Reber's disclosure and enablement of a food storage apparatus and a method of monitoring a food item, please consider the following excerpts:

⁹ *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968).

¹⁰ Reber, et al. (U.S. Patent No. 5,798,694), Title Block (54).

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- The system includes a food storage apparatus 22 for containing the food item 20 and a storage place 24 for storing the food storage apparatus 22. (column 2, lines 14-18)
- The food storage apparatus 22 includes a container 26 for containing the food item 20. (column 2, lines 19-20)
- Optionally, the food storage apparatus 22 includes a cover 28 to cover the opening of the container 26. (column 2, lines 25-26)
- The container 26 and the cover 28 can be suited for storing and dispensing perishable food items, dry food items, liquid food items, or any combination thereof. (column 2, lines 44-46)
- The food storage apparatus 22 includes an electronic tag 30 ... to monitor at least one condition of the food item 20. (column 3, lines 23-28)
- The indicator 36 can provide an alert or a warning of the condition of the food item 20. (column 3, lines 64-65)
- As with the indicator 36, the indicator 40 can provide either an audible indication or a visual indication of a condition of the food item 20.... (column 4, lines 5-8)
- In a preferred embodiment, the indication is utilized to alert an individual of a condition in which a food item requiring refrigeration should be discarded. (column 4, lines 28-31)

Reber discloses and enables a food storage apparatus and a method of monitoring a food item having little or nothing to do with a system of inventory control as claimed in the present application. As further evidence of the lack of disclosure and enablement in

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Reber regarding a system of inventory control as claimed in the present application, please note that not one of the following terms or phrases from claims 11-20 of the present application occurs anywhere in Reber, not even once:

- inventory item attributes
- computer memory
- inventory item
- RFID identification tag
- RFID identification tag code field
- control value
- acceptable control value range
- out of range action
- detecting changes
- RFID reader
- recording
- comparing the control value
- taking action
- Java
- OSGI
- gateway
- pounds
- reading the weight
- weight
- scale
- clock
- thermometer
- freshness coefficient
- utilization
- inventory storage location
- quantity

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- separate items
- count
- days
- date
- entered inventory
- calculating the age
- storing the age
- emailing
- order
- vendor
- reorder the inventory item
- advising the user

In these circumstances there is no sound basis for believing that Reber in any way discloses or enables elements of claims 11-20 in the present application. Reber discloses a food storage apparatus and method for monitoring a food item, while the present application claims a system of inventory control. Reber also never once mentions many of the words in Applicants' claims 11-20. The Office action therefore does not establish anticipation under 35 U.S.C. § 102(b) using Reber. The rejection of the claims 11-20 should be withdrawn, and the claims should be allowed.

The Theory of Inherency Is Not Available As A
Basis For Rejection Of Claims In The Present Case

The Office Action at numbered paragraph 13, regarding Reber, states:

Reber discloses an RFID inventory system with RFID identification tag code field (inherent)...

In an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Office Action. Applicants therefore assume that the Office

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Action intends to invoke the theory of inherency as a basis for anticipation of the "RFID identification tag code field" element of claim 11 in the present application. The Office Action takes the position in effect that some disclosure in Reber necessarily results in the claim element recited above of a RFID inventory system with RFID identification tag code field. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. Merely reciting the word "inherent" is insufficient basis for a rejection on the theory of inherency. In *Ex parte Levy*, the Board of Patent Appeals and Interferences states, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."¹¹ The Office Action does not demonstrate in any way that anything in Reber necessarily results in a RFID inventory system with RFID identification tag code field. In fact, such inherency does not exist. A RFID inventory system with RFID identification tag code field cannot properly be said to necessarily flow from any of the teaching in Reber within the meaning of *Levy*. For this reason alone, Reber can be seen to not disclose or teach the claim element asserted on its behalf. Claim 11 therefore is patentable and should be allowed. Dependent claims 12-20 depend from independent claim 11. These dependent claims include each and every limitation of the independent claim from which they depend. These dependent claims stand because their independent claim stands.

In rejecting claims 11-20 under 35 U.S.C. § 102(b) as being anticipated by Reber, the Office Action does not satisfy the legal requirements for rejections under 35 U.S.C. § 102(b). The Office Action fails to provide Applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132 and therefore relieves Applicants of any duty to respond to the rejection. In a best effort to be fully responsive, however, Applicants demonstrate above that the Office Action has not established anticipation by Reber because the Office Action does not even mention many of the elements of the Applicants' claims. Even examining Reber itself confirms

¹¹ *Manual of Patent Examination and Procedure* § 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

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that Reber does not anticipate each and every element of the Applicants' claims, expressly or inherently. Applicants therefore traverse the rejection to each of claims 11-20 in the present application. The rejections of all claims 11-20 under 35 U.S.C. § 102, therefore, should be withdrawn, and the claims should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 11-20 stand rejected under 35 U.S.C § 103(a) as unpatentable over Reber in view of prior art that “would have been obvious to a person having ordinary skill in the art at the time the invention was made. Applicants understand the Examiner’s reference to ‘ordinary skill’ to be a reference to ‘Well Known Prior Art.’ Applicants respectfully submit in response that the Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution. In addition, Well Known Prior Art is unavailable as a reference in this Office Action. Moreover, the proposed combination of Reber and Well Known Prior Art does not teach each and every element of the claims of the present application. In addition, there is no suggestion or motivation to make the proposed combination. Finally, there is no reasonable expectation of success in the proposed modification. For all these reasons, the rejections should be withdrawn and the claims should be allowed.

The Office Action Fails To Provide The Applicants With
Information Sufficient To Judge The Propriety Of
Continuing Prosecution As Required By 35 U.S.C. § 132

As noted above, 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for a rejections, including “such information and references as may be useful in judging of the propriety of continuing the prosecution....” 37 C.F.R. § 1.104(c)(2) second sentence requires, “When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of “...the particular figures(s) of the

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drawing(s), and/or page(s) or paragraph(s) of the reference(s)....” MPEP § 707.07(d) warns against omnibus rejections as, “...stereotyped and usually not informative and should therefore be avoided.”

As mentioned above, the reference to Reber in the Office Action makes no mention of where in Reber the information relied on by the Examiner may be found. Regarding Well Known Prior Art, the Office Action generally states:

...the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety.

Other than generally citing Reber and Well Known Prior Art, the Office Action remains completely silent regarding the location of the information relied on by the Examiner as to claims 11-20. Both Reber and the Well Known Prior Art are complex references containing information regarding many technical subjects and other inventions. In light of the requirements of 35 U.S.C. § 132, it is important for the Examiner to provide some indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed or suggested in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Reber and the Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections.

For these reasons alone, the rejection of the claims 11-20 should be withdrawn, and the claims should be allowed. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants

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undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

Well Known Prior Art Is
Not Available As A Reference

In the absence of any indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §103. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

In rejecting claims 11-20 for obviousness under 35 U.S.C. § 103, the Office Action at numbered paragraph 15 states:

...it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Reber to expressly indicate an RFID identification tag code field. Such a modification would have made it clear that RFID tags require unique ID numbers in order to properly identify the tag.

As stated above, the 'ordinary skill' so described is taken in this Response as 'Well Known Prior Art.' Applicants understand, based on this language from the Office Action, that this rejection, based on 'ordinary skill' so described, is a rejection relying on common knowledge or Well Known Prior Art according to MPEP 2144.03. Applicants respectfully propose, however, that "to modify Reber to expressly indicate an RFID identification tag code field" is not available to the Examiner in this case as Well Known Prior Art.

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According to MPEP § 2144.03, the Examiner may use as Well Known Prior Art facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Well Known Prior Art, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. As indicated in *In re Lee*, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied reference must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record."¹² The court in *Lee* requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in *In re Bozek*,¹³ may only be applied to analysis of the evidence, rather than be a substitute for evidence.¹⁴

In this case, Applicants note with respect that the Examiner has made a mere naked assertion that a fact is well known in the prior art with absolutely no "objective evidence of record" and no expression of any reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. As mentioned, Well Known Prior Art may not be substituted for facts which cannot be instantly and unquestionably demonstrated. For these reasons, the Examiner in this case cannot have recourse to facts well known in the prior art. This rejection therefore fails to establish a *prima facie* case of obviousness. Claims 11-20 are therefore patentable and should be allowed.

Reber and Well Known Prior Art

In the absence of any indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §103. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best

¹² *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

¹³ *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

¹⁴ *In re Lee*, 277 F.3d 1345, 61 USPQ2D at 1435.

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guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

To establish a prima facie case of obviousness, three basic criteria must be met in accordance with MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references.¹⁵ The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references.¹⁶ The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations.¹⁷

The Combination Of Reber and Well Known Prior Art
Does Not Teach all Of Applicants' Claim Limitation

To establish a prima facie case of obviousness under 35 U.S.C. § 103, the proposed combination of the references must teach or suggest all of Applicants' claim limitations.¹⁸ In rejecting claims 11-20 under 35 U.S.C. § 103, the Office Action relies exclusively on Reber for disclosure or suggestion of several of the elements of claim 11.¹⁹ As shown above, Reber does not disclose those elements relied on by the Office Action. The proposed combination of Reber and Well Known Prior Art therefore cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claim 11 of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination. Dependent claims 12-20 depend from independent claim 11. These dependent claims include each and every limitation of the independent claim from which they depend. These dependent claims stand because

¹⁵ *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

¹⁶ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

¹⁷ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

¹⁸ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

¹⁹ Office Action at numbered paragraph 15.

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their independent claim stands. The rejections of all claims 11-20 under 35 U.S.C. § 103, therefore, should be withdrawn. Applicants respectfully traverse the rejection to each of claims 11-20 and request claims 11-20 be allowed.

No Suggestion or Motivation to Combine Reber
And The Well Known Prior Art

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Reber. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Reber must come from the teaching of the cited art itself, and the Examiner must explicitly point to the teaching within the cited art suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

In this case, the Office Action makes no mention whatsoever of any evidence of suggestion or motivation to modify Reber, neither in Reber itself nor in Well Known Prior Art. As such, no proposed modification of Reber can establish a prima facie case of obviousness. For this reason, the rejection of claim 11 should be withdrawn, and claim 11 and all claims 12-20 depending from it should be allowed.

No Reasonable Expectation of Success in the
Proposed Combination of Reber and Well Known Prior Art

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Reber. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of

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success in a proposed modification if the proposed modification changes the principle of operation of Reber. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this case, the Office Action makes no mention whatsoever of any evidence that a reasonable expectation of success in a proposed combination of Reber's disclosure of a food storage apparatus and a method of monitoring a food item with the "expressly indicate an RFID identification tag code field" from Well Known Prior Art to produce claim 11 of the present application. As such, no proposed modification of Reber can establish a prima facie case of obviousness. For this reason, the rejection of claim 11 should be withdrawn, and claim 11 and all claims 12-20 depending from it should be allowed.

Neither Reber nor Reber combined with Well Known Prior Art discloses each and every element of claims 11-20. There is no suggestion to combine Reber and Well Known Prior Art in either reference, and there is no reasonable expectation of success in the proposed combination. The Office Action therefore does not establish a prima facie case of obviousness under 35 U.S.C. § 103. Applicants respectfully traverse the rejection to each of claims 11-20 and request that claims 11-20 be allowed.

Lexicography of the Specification

The Office Action in numbered paragraph 17 states that "...the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning." The Office Action further defines various terms used by the Examiner as guides to claim terminology such as "computer", "server", "client", "data", "gateway", "network", "acceptable", and "information."²⁰ MPEP § 2111.01 states, "In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings

²⁰ Office Action at numbered paragraphs 18-19.

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is most consistent with the use of the words by the inventor.”²¹ MPEP § 2111.01 further provides that all claims are to be interpreted as broadly as their terms reasonably allow.²² To aid the Examiner in interpreting the claims composed of 2,355 words as broadly as their terms reasonably allow, the Applicants have provided a specification of 50 pages that includes eleven drawings and a section of definitions. MPEP § 2106 states, “Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.”²³ Regarding the definitions provided in the Office Action, Applicants cite MPEP § 2111.01 stating “[i]f more than one extrinsic definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all consistent meanings.”²⁴ Subject to these comments, however, applicants respectfully decline to interpret claim terms further in view of the risk of prosecution history estoppel within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyokabushiki Co.*²⁵ The MPEP, as cited above, provides the Examiner with a sufficient framework for claim interpretation. Applicants’ make no admissions whatsoever regarding any particular interpretation of the claims. Applicants are entitled to and encourage the interpretation of claims as broadly as their terms reasonably allow to encompass all consistent meanings.

Subject Matter of Claims 11-30

The Office Action at numbered paragraph 20 states:

With respect to claims 11-30, the Examiner respectfully reminds Applicants that: “A system is an apparatus.” ... Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory

²¹ *Manual of Patent Examination and Procedure* § 2111.01 II (citing *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003)).

²² *Manual of Patent Examination and Procedure* § 2111.01 I.

²³ *Manual of Patent Examination and Procedure* § 2106 II C; *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”).

²⁴ *Manual of Patent Examination and Procedure* § 2111.01 II (citing *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203, 64 USPQ2d 1812, 1819 (Fed. Cir. 2002)).

²⁵ *Festo Corp. v. Shoketsu Kinzoku Kogyokabushiki Co.*, 122 S. Ct. 1831, 535 U.S. 722, 152 L. Ed. 2d 944, 62 U.S.P.Q.2d 1705 (2002).

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category of a 'machine.'" Therefore, it is the Examiner's position that Applicants' system claims are "product," "apparatus," or more specifically, "machine" claims.

Applicants gratefully acknowledge that claims 11-20 are directed to a system patentable under 35 U.S.C. § 101. Applicants note with respect, however, that the computer program products claimed in claims 21-30 are articles of manufacture within the meaning of 35 U.S.C. § 101.

Official Notice of Fact Not Available As A Reference

The Office Action at numbered paragraph 21 states:

...[I]t is the Examiner's factual determination that bar code tags and radio frequency ("RF") tags are art recognized equivalents. See MPEP §2144.06. Both bar code tags and RF tags are used for the same purpose: conveying information about the article to which the tags are attached to a read machine. Additionally, one of ordinary skill in the art recognizes that the selection of either a bar code tag over an RF tag (or vice versa, RF tag over a bar code tag) is not enough to distinguish a claimed invention over the prior art since both devices are recognized as interchangeable. See MPEP §2144.07.

These statements in the Office Action amount to a use of Well Known Prior Art as a basis for a finding of obviousness – with no evidentiary support. With respect, Applicants submit that the Examiner is not free to use Well Known Prior Art in this manner in the absence of evidence that the fact asserted is capable of instant and unquestionable demonstration as being well-known in the art. Well Known Prior Art may not be substituted for facts which cannot be instantly and unquestionably demonstrated.

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In this case, Applicants submit with respect that the Examiner has made a mere naked assertion that a bar code tags and RFID tags are recognized equivalents in the prior art with no objective evidence of record. The Office Action instead merely cites ten different patents without providing Applicant's any references as to any location in those patents of any information on which the Examiners relied in forming a conclusion regarding well known prior art. In light of the requirements of 35 U.S.C. § 132 explained above, it is essential for the Office Action to provide some indication of where the Examiner finds support in these references for the above conclusions. Without these references, Applicants do not have enough information to judge how to proceed with the prosecution of the present application. Moreover, in the absence of any indication of where within these ten patent references the Examiner believes bar code tags and RF tags are disclosed to be equivalents, Applicants cannot understand the reasons for the rejections.

In addition regarding the equivalence of bar coding and RFID, Applicants submit that the ten patents cited in an omnibus fashion by the Examiner in this case cannot possibly support the conclusion of equivalence in the prior art for bar code tags and RFID tags. Consider Eberhardt (U.S. Patent 5,382,784), for example. Eberhardt describes a hand-held dual technology identification tag reading head, a device for reading both bar code tags and RFID tags. It is important to note, however, that the device disclosed in Eberhardt requires the inclusion of two completely different reading technologies within the device in order to read both bar code tags and RFID tags, a laser reader for bar code tags and a radio frequency reader for RFID tags. The same distinction between bar coding and RFID technology is evident in all of the ten patents cited in the Office Action. Scribner (U.S. Patent 4,688,026), for example, beginning at column 1, line 32, affirmatively discusses at some length the functional differences between bar coding and RFID. In view of their completely separate fundamental nature, it is simply not possible that there may be evidence anywhere of the kind of functional equivalence or interchangeability between bar codes and RFID alleged in the Office Action in the present case.

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Product-by-Process Claims

Applicants acknowledge with gratitude the Examiner's advice that claims 1-30 contain no product-by-process claims.

Relationship Among the Claims

Claims 1-10 and 21-30 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over Reber. Claims 1-10 and 21-30 claim method and computer program product aspects respectively of the systems claimed in claims 11-20, a relationship acknowledged in the Office Action at numbered paragraph 16. If claims 11-20 stand, then claims 1-10 and 21-30 stand also. Claims 11-20 are patentable for the reasons mentioned above. Because claims 11-20 stand, claims 1-10 and 21-30 also stand. Applicants respectfully traverse the rejection individually of claims 1-30 because these claims are patentable and should be allowed.

Conclusion

For the reasons set forth in detail above in this Response, Applicant submit that all objections to and rejections of the claims in the present case should be withdrawn, and the claims should be allowed. Applicants respectfully request reconsideration of all the claims in the present case in view of the remarks set forth above.

Respectfully submitted,

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